

REMARKS

Original claims 1 and 2 have been replaced by new claims 3 and 4, which are believed to be proper as to form and clearly patentable over the cited references.

Reconsideration is accordingly respectfully requested, for the rejection of the claims as anticipated by EP 0 882 544, or as unpatentable over JP 8-132279 or WO 99/55924.

EP 0 882 544 discloses, on page 3, Table 1, line 3 from the bottom, a soldering alloy consisting of 3% silver, 1.5% zinc, 7% bismuth, balance tin.

New claim 3 recites subject matter unobvious in view of this disclosure, by reciting 7.5 to 10% by weight of bismuth. The original disclosure of our application is 5 to 10% by weight of bismuth. Therefore, applicants were in possession of 7.5% at the time the invention was made, and are entitled to claim it. Furthermore, 7.5% is substantially different from 7% and is not made obvious by 7%.

New claim 4 distinguishes patentably over EP 0 882 544, by the recitation of an effective amount of indium not more than 5% by weight, this amount being effective to increase the joint strength over 1,000 hours at 100°C.

Notice on page 4 of our specification, Table 1, wherein is set forth the composition of Example 5, containing indium. Notice that, among all the examples set forth in Table 1, Example

5 is the only one in which the joint strength actually increases after 1,000 hours at 100°C. In all the other examples, the joint strength decreases, by the percentages set forth in the right-hand column of Table 1. Thus, the inclusion of indium in an amount effective to do this, is unobvious in view of EP 0 882 544, in which indium is not mentioned other than in page 2, line 33 thereof, where those skilled in the art are taught not to use indium.

As the Examiner recognized by applying 35 USC §103 instead of §102, the other two applied references, JP 8-132279 and WO 99/55924 are even more remote from the present invention than is the European reference. JP 8-132279 discloses a wide range of alloy metals; but it would have been unobvious to anyone of ordinary skill in the art to have picked, from among this recitation of nine different metals, those of the present invention in the proportions of the present invention.

Finally, the wheel balancing weights of WO 99/55924 have so many "and/or" possible components that the number of different alloys is almost infinite. Those of the present invention, for an entirely different purpose, could be reached only by very selective picking and choosing among the extremely wide range of metals disclosed. Thus, when we come down to particular examples on page 15 of WO 99/55924, we see that they

Application No. 10/046,781
Amdt. dated January 12, 2004
Reply to Office Action of September 15, 2003
Docket No. 8007-1003

bear no resemblance to the present invention. But why should they, when they are for an entirely different purpose?

In view of the present amendment and the foregoing remarks, therefore, it is believed that this application has been placed in condition for allowance, and reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



Robert J. Patch, Reg. No. 17,355
745 South 23rd Street
Arlington, VA 22202
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

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